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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,761	02/20/2002	Hiroshi Sawada	JCLA8894	3473

7590 04/03/2003

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EXAMINER

ESTRADA, MICHELLE

ART UNIT

PAPER NUMBER

2823

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/084,761	SAWADA, HIROSHI	
	Examiner Michelle Estrada	Art Unit 2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 January 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3,4,6,7 and 9-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,3,4,6,7 and 9-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 7, 9-11, 14, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Harris et al. (3,824,678) and Haight et al. (6,333,485).

Harris et al. disclose irradiating a substrate with pulse laser to cut it (Col. 2, lines 58-60); the surface of the substrate is irradiated with the laser; the substrate is a semiconductor substrate formed with a number of elements and said pulse laser is irradiated along the scribed lines between said elements (Col. 6, lines 59-60). Harris et al. discloses that the back of the semiconductor wafer is drawn by an x-y table (Col. 6, lines 19-25); the laser is irradiated to the semiconductor wafer excluding the peripheral portion.

Harris et al. does not disclose the specific pulse width of the laser.

Haight et al. disclose cutting and removing material from a sample by a laser operating in pulse widths to the picosecond (Col. 2, lines 22-23).

It would have been within the scope of one of ordinary skill in the art to combine the teachings of Harris et al. and Haight et al. to achieve the cutting step of the substrate.

Alternatively, choice of a particular pulse width would have been a matter of routine experimentation within the teachings of the references.

Harris et al. discloses the claimed invention except for the pulse width of the laser. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pulse width of one or less than one picoseconds, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

In addition, the selection of the pulse width, its obvious because it is a matter of determining optimum process conditions by routine experimentation with a limited number of species of result effective variables. These claims are *prima facie* obvious without showing that the claimed ranges achieve unexpected results relative to the prior art range. *In re Woodruff*, 16 USPQ2d 1935, 1937 (Fed. Cir. 1990). See also *In re Huang*, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996)(claimed ranges or a result effective variable, which do not overlap the prior art ranges, are unpatentable unless they produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art). See also *In re Boesch*, 205 USPQ 215 (CCPA) (discovery of optimum value of result effective variable in known process is ordinarily within skill or art) and *In re Aller*, 105 USPQ 233 (CCPA 1995) (selection of optimum ranges within prior art general conditions is obvious).

Note that the specification contains no disclosure of either the critical nature of the claimed pulse width or any unexpected results arising therefrom. Where

patentability is said to be based upon particular chosen pulse width or upon another variable recited in a claim, the Applicant must show that the chosen pulse width is critical. *In re Woodruf*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Choice of a particular thickness of the semiconductor wafer would have been considered a matter of routine optimization. See MPEP 2144.05.

Claims 12, 13, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. in combination with Haight et al. as applied to claims 1, 3, 4, 6, 7, 9-11, 14, 15, 17 and 18 above, and further in view of Usami (6,440,773).

The combination of Harris et al. and Haight et al. does not disclose that the semiconductor wafer has a batch-processed adhesive agent layer on the back.

Usami discloses applying an adhesive to the back of the substrate (4907) and cutting the wafer with a laser (Claim 3).

It would have been within the scope of one of ordinary skill in the art to combine the teachings of Harris et al., Haight and Usami to enable formation of the wafer and further the adhesive provides protection to the substrate in subsequent steps.

Response to Arguments

Applicant alleges that unexpected results were obtained. However, the applicant has merely recognized properties of the process made obvious by the combination. Furthermore, applicant does not point to objective evidence establishing unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Estrada whose telephone number is (703) 308-0729. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 703-306-2794. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



George Fourson
Primary Examiner
Art Unit 2823



MEstrada
March 26, 2003